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Abdul-Jabbar v. General Motors Corp.

85 F.3d 407 (9th Cir. 1996)

INTRODUCTION

Kareem Abdul-Jabbar (“Abdul-Jabbar”) brought suit against General Motors Corporation and its advertising agency, Leo Burnett Co., (collectively “GMC”), alleging violations of the Lanham Act¹ and California’s statutory and common law right of publicity.² The United States District Court for the Central District of California found that Abdul-Jabbar had “abandoned the name Lew Alcindor, and ... abandoned the right to protect that name, and the right to assert any other rights that flow from his having had that name at one time in the past.”³ As a result, the court granted summary judgment in favor of GMC on both the Lanham Act and the state law causes of action.⁴ The United States Court of Appeals for the Ninth Circuit reversed and remanded. The reviewing court held “that the question of whether Abdul-Jabbar’s Lanham Act claim should succeed is a question for the jury ... because [it] could reasonably conclude that ... [certain] factors weigh in plaintiff’s favor.”⁵ Similarly, with respect to the state law claims, the appellate court held that “[w]hether or not Lew Alcindor ‘equals’ Kareem Abdul-Jabbar ... is a question for the jury.”⁶

FACTS

Kareem Abdul-Jabbar was named Ferdinand Lewis “Lew” Alcindor when he was born and played basketball under that name

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1. 15 U.S.C. §1125 (a) (1992).
 2. Kareem Abdul-Jabbar v. General Motors, Corp., 85 F.3d 407, 409 (9th Cir. 1996).
 3. *Id.* at 410.
 4. *Id.*
 5. *Id.* at 413.
 6. *Id.* at 414.

throughout his college career and into his early years in the National Basketball Association (“NBA”).⁷ Abdul-Jabbar converted to Islam during college and used the name “Kareem Abdul-Jabbar” among friends. It was not until several years later, in 1971, that he recorded the name under an Illinois recordation statute.⁸ Thereafter, Abdul-Jabbar played basketball and endorsed products under that name, and has not used the name “Lew Alcindor” for commercial purposes in more than ten years.⁹

Abdul-Jabbar’s complaint arises out of a GMC television commercial that aired during the 1993 NCAA men’s basketball tournament.¹⁰ The commercial consisted of a disembodied voice, silent printed messages on the screen, and a picture and price of an automobile. The advertisement begins with the voice asking, “How ‘bout some trivia?”¹¹ This is followed by the printed words, “You’re talking to the champ.”¹² The voice then asks, “Who holds the record for being voted the most outstanding player in this tournament?”¹³ A printed message follows stating, “Lew Alcindor, UCLA ‘67, ‘68, ‘69.”¹⁴ Next, the voice asks, “Has any car made the ‘Consumer Digest’s Best Buy’ list more than once? The Oldsmobile Eighty-Eight has.”¹⁵ The automobile and its price then appear, followed by more vocal and visual messages.

GMC did not obtain Abdul-Jabbar’s consent nor pay him for the use of his former name during this commercial.¹⁶ The ad aired approximately five or six times during March of 1993. Once Abdul-Jabbar complained to GMC about the commercial, the company promptly withdrew it.¹⁷ The parties are in dispute over whether Abdul-Jabbar abandoned the name Lew Alcindor and whether the ad could be construed as an endorsement by Abdul-Jabbar of the

7. *Id.* at 409.

8. *Id.*

9. *Id.*

10. *Id.*

11. *Id.*

12. *Id.*

13. *Id.*

14. *Id.*

15. *Id.*

16. *Id.*

17. *Id.*

Oldsmobile.¹⁸

LEGAL ANALYSIS

This appeal was taken from a grant of a summary judgment motion for GMC. The appellate court began its analysis with the issue of summary judgment. In reviewing a grant of a summary judgment motion, “[a]n appellate court must determine, viewing the evidence in the light most favorable to the nonmoving party, whether there are any genuine issues of material fact, and whether the district court correctly applied the relevant substantive law.”¹⁹ A court must not “weigh the evidence or determine the truth of the matters asserted but only determine whether there is a genuine issue for trial.”²⁰

I. THE LANHAM ACT

“[A]n express purpose of the Lanham Act is to protect commercial parties against unfair competition.”²¹ In *Waits v. Frito-Lay, Inc.*, the Ninth Circuit held that false endorsement claims are properly cognizable under section 43(a) of the Lanham Act.²² Accordingly, the Ninth Circuit held actionable a “false endorsement claim based on the unauthorized use of a celebrity’s identity ... [which] alleges the misuse of a trademark, i.e., a symbol or device as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff’s sponsorship or approval of the product.”²³ Abdul-Jabbar’s first contention is that GMC’s unauthorized use of his birth name, Lew Alcindor, is likely to confuse consumers as to his endorsement of the Olds Eighty-Eight, and thus violates the Lanham Act.²⁴

In response to Abdul-Jabbar’s claim, GMC raised two defenses: 1.)

18. *Id.* at 409-10.

19. *Jesinger v. Nevada Federal Credit Union*, 24 F.3d 1127, 1130 (9th Cir. 1994).

20. *Id.* at 1131.

21. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1108 (9th Cir. 1992).

22. *Id.* at 1107.

23. *Abdul-Jabbar*, 85 F.3d at 410.

24. *Id.*

Abdul-Jabbar lost his rights to the name Lew Alcindor when he “abandoned” it; and 2.) GMC’s use of the name Lew Alcindor was a nominative fair use which is not subject to the protection of the Lanham Act.²⁵ The district court found both defenses valid, and used 15 U.S.C. §1127 to support its view of the abandonment defense. Section 1127 provides in relevant part:

A mark shall be deemed to be “abandoned” when one of the following occurs: (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of that mark made in the ordinary course of trade, and not merely to reserve a right in a mark. (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become ... generic ...²⁶

After a prima facie case of abandonment has been made, however, it may be rebutted by showing valid reasons for nonuse or lack of intent to abandon the mark.²⁷ Since Abdul-Jabbar admitted that he had not used the name Lew Alcindor in over ten years, and because the district court found that his proffered religious reasons for nonuse were not applicable, the court held that Abdul-Jabbar had in effect abandoned the name.²⁸

In disagreeing with the district court, the appellate court noted that “[w]hile the Lanham Act has been applied to cases alleging appropriation of a celebrity’s identity, the abandonment defense has never to our knowledge been applied to a person’s name or identity.”²⁹ The appellate court refused to “stretch” federal trademark

25. *Id.*

26. 15 U.S.C. §1127 (1992).

27. *Star-Kist Foods, Inc. v. P.J. Rhodes & Co.*, 769 F.2d 1393, 1396 (9th Cir. 1985).

28. *Abdul-Jabbar*, 85 F.3d at 411.

29. *Id.*

law to include such a defense because a person's birth name is not given for commercial reasons and, therefore, cannot be abandoned during the possessor's life simply because of a lack of commercial use.³⁰ The court went even further, stating that "[a]n individual's decision to use a name other than the birth name--whether the decision rests on religious ... or other personal considerations--does not therefore imply intent to set aside the birth name, or the identity associated with that name."³¹

The district court also cited the "fair use" defense, as an alternate ground for dismissal of Abdul-Jabbar's Lanham Act claim.³² The Ninth Circuit dealt with this defense in *New Kids on the Block v. News America Publishing, Inc.*, in which it held that the use by two newspapers of the "New Kids" name to conduct phone-in polls measuring the group's popularity was a nominative "fair use" of the name not subject to protection under the Lanham Act.³³ The court held that a commercial user would be entitled to the nominative fair use defense if it could meet three requirements: 1.) the product or service in question must be one not readily identifiable without use of the trademark; 2.) only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and 3.) the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.³⁴ The court found that all three requirements were met and the newspapers were entitled to the nominative fair use defense.³⁵

In the instant case, the district court held all three *New Kids* requirements satisfied, but the appellate court concluded that there was a genuine issue of fact as to the third requirement, implied endorsement or sponsorship.³⁶ The Ninth Circuit reasoned that the critical distinction between the present case and the *New Kids* case was that "use of celebrity endorsements in television commercials is

30. *Id.*

31. *Id.* at 412.

32. *Id.*

33. *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 306-09 (9th Cir. 1992).

34. *Id.* at 307-8.

35. *Id.* at 308-10.

36. *Abdul-Jabbar*, 85 F.3d at 412.

so well established by commercial custom that a jury might find an implied endorsement in General Motors' use of the celebrity's name in a commercial, which would not inhere in a newspaper poll."³⁷ Accordingly, the court held that "[l]ikelihood of confusion as to endorsement is ... a question for the jury."³⁸ The court offered more insight into its ruling when it added that GMC might have been able to defend the Lew Alcindor reference as a fair use if it had limited itself solely to the trivia portion of the commercial.³⁹ By using Alcindor's record to make a claim for the car, "GMC has arguably attempted to 'appropriate the cachet of one product for another,' if not also to 'capitalize on consumer confusion.'"⁴⁰ In light of the foregoing reasons, the court held that there was a "question of fact as to whether GMC [was] entitled to a fair use defense."⁴¹ In concluding its discussion of the Lanham Act claim, the court acknowledged that, in the past, it had considered several factors to determine if a plaintiff had "raised a genuine issue of material fact as to the likelihood of confusion over endorsement: '(1) strength of the plaintiff's mark; (2) relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; and (7) defendant's intent in selecting the mark.'"⁴² The court held that "[b]ecause a jury could reasonably conclude that most of the factors weigh in plaintiff's favor ... the question of whether Abdul-Jabbar's Lanham Act claim should succeed is a question for the jury."⁴³

37. *Id.* at 413.

38. *Id.*

39. *Id.*

40. *Id.* (quoting *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 308 (9th Cir. 1992)).

41. *Abdul-Jabbar*, 85 F.3d at 413.

42. *Id.* (quoting *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992)) (holding that use of a robot dressed and posed like Vanna White next to a "Wheel of Fortune" set raised sufficient question of fact as to endorsement under the Lanham Act to preclude summary judgment), *cert. denied*, 508 U.S. 951 (1993).

43. *Abdul-Jabbar*, 85 F.3d at 413.

II. STATE LAW CLAIMS: COMMON LAW AND STATUTORY RIGHTS OF PRIVACY

The Ninth Circuit relied heavily on *Eastwood v. Superior Court for Los Angeles County*⁴⁴ in its analysis of Abdul-Jabbar's state law claim. The *Eastwood* court held that "California has long recognized a common law right of privacy ... [which includes protection against] appropriation, for the defendant's advantage, of the plaintiff's name or likeness."⁴⁵ "The right to be protected against such appropriations is also referred to as the 'right of publicity.'"⁴⁶ The *Eastwood* court set out four factors necessary to plead a common law cause of action for appropriation of name or likeness: "(1) the defendant's use of plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury."⁴⁷ In past cases of this nature, the Ninth Circuit has taken a very broad view of the common law, holding that "California's common law 'right of publicity is not limited to the appropriation of name or likeness.'"⁴⁸ "The key issue [for the Ninth Circuit] is appropriation of the plaintiff's identity."⁴⁹

The common law cause of action in California is "complemented legislatively by Civil Code section 3344."⁵⁰ In referring to the relationship between the common law and the statute, the Ninth Circuit borrowed the term "complement" from the *Eastwood* court, which explained that the "statute is best understood as 'complementing,' rather than enacting the common law cause of action, because the two are not identical."⁵¹ Section 3344(a) provides

44. *Eastwood v. Superior Court for Los Angeles County*, 149 Cal. App. 3d 409, 198 Cal. Rptr. 342 (1983).

45. *Abdul-Jabbar*, 85 F.3d at 413 (quoting *Eastwood*, 149 Cal. App. 3d at 416, 198 Cal. Rptr. at 346).

46. *Id.* at 413 (quoting *Eastwood*, 149 Cal. App. 3d at 409, 198 Cal. Rptr. at 347).

47. *Id.* at 414 (quoting *Eastwood*, 149 Cal. App. 3d at 417, 198 Cal. Rptr. at 347).

48. *Id.* at 414 (quoting *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992)).

49. *Abdul-Jabbar*, 85 F.3d at 414 (emphasis added).

50. *Id.*

51. *Id.* (quoting *Eastwood*, 149 Cal. App. 3d at 416, Cal. Rptr. at 346).

in pertinent part:

Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purchases of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, without such person's prior consent ... shall be liable for any damages sustained by the person ... injured as a result thereof.⁵²

"In addition to the common law elements, the statute requires two further allegations: 1) knowing use; and 2) a 'direct connection ... between the use and the commercial purpose.'"⁵³ The Ninth Circuit views section 3344 as limited to commercial purposes and it has "construed the statute's protection of 'name, voice, signature, photograph, or likeness' more narrowly than the common law's protection of 'identity.'"⁵⁴

The district court held "that GMC was entitled to summary judgment on both the statutory and common law causes of action."⁵⁵ With respect to the statutory claim, the district court "reasoned that section 3344 did not apply because: 1) Abdul-Jabbar had abandoned his former name; and 2) GMC did not 'use' plaintiff's name because Abdul-Jabbar 'did not [at the time of the ad] and does not have the name used.'"⁵⁶ The district court held that Abdul-Jabbar abandoned the name Lew Alcindor when he legally recorded his present name in 1971.⁵⁷ The district court dismissed the common law cause of action for similar reasons. The district court distinguished *Carson v. Here's*

52. Cal. Civ. Code §3344(a) (West 1971).

53. *Abdul-Jabbar*, 85 F.3d at 414 (quoting *Eastwood*, 149 Cal. App. 3d at 417, 198 Cal. Rptr. At 347).

54. *Abdul-Jabbar*, 85 F.3d at 414; See, e.g., *White*, 971 F.2d at 1397 (holding plaintiff stated a cause of action under common law but not under §3344 where likeness in question was a robot impersonating celebrity).

55. *Abdul-Jabbar*, 85 F.3d at 414.

56. *Id.*

57. *Id.*

Johnny Portable Toilets, Inc.,⁵⁸ “on the grounds that ‘[o]ne cannot say that Lew Alcindor equals Kareem Abdul-Jabbar in anywhere near the same sense that ‘Here’s Johnny’ equals Johnny Carson ...”⁵⁹ The district court described the crucial factor of the holding “in *Carson* ... to be ‘that the ... nickname must be in the most common present use so that it clearly identifies the person seeking recovery.’”⁶⁰

The Ninth Circuit felt that the cases used by the district court to support its view did not reflect the “proposition that the reference must be ‘in common, present use’ under the statute or under California common law.”⁶¹ Also, the appellate court felt that the lower court’s common, present use analysis was just a variation on the abandonment argument, that is, that Abdul-Jabbar can only sue for the use of his present name since he has abandoned the use of his former name.⁶² Furthermore, the appellate court agreed with Abdul-Jabbar’s argument that “abandonment cannot be a defense to appropriation because the right of publicity protects not only a celebrity’s ‘sole right to exploit’ his identity, but also his decision not to use his name or identity for commercial purposes.”⁶³

The appellate court ultimately held that Abdul-Jabbar had alleged sufficient facts to state a claim under both California common law and section 3344 because the statute’s reference to name or likeness is not limited to present or current use.⁶⁴ Also, the appellate court believed that “[w]hether or not Lew Alcindor ‘equals’ Kareem Abdul-Jabbar in the sense that ‘Here’s Johnny equaled Johnny Carson’ ... is a question for the jury.”⁶⁵ Abdul-Jabbar also submitted evidence to show that he was injured economically because the ad will make it difficult for him to endorse other automobiles, and emotionally because people may be led to believe that he has abandoned his current name and assume he has renounced his

58. *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

59. *Abdul-Jabbar*, 85 F.3d at 415.

60. *Id.*

61. *Id.*

62. *Id.* at 414.

63. *Id.* (quoting *White*, 971 F.2d at 1399).

64. *Id.*

65. *Id.* at 416.

religion.⁶⁶ These allegations suffice to support his cause of action.⁶⁷

CONCLUSION

The United States Court of Appeals for the Ninth Circuit refused to allow the defense of abandonment to reach so far as to make a celebrity's name generic simply because there was a lack of commercial use.⁶⁸ The court held that a person's name is unique and "has a life and a significance quite apart from the commercial realm."⁶⁹ The court also held that summary judgment was inappropriate with respect to the "fair use" doctrine because, out of the three requirements set out in *New Kids*, there existed a genuine issue of fact with respect to the third requirement dealing with implied endorsement or sponsorship.

With respect to the state law claims, the court read the common law cause of action very broadly focusing on the idea of identity. The court felt that it was "not important how the defendant ha[d] appropriated the plaintiff's identity, but whether the defendant ha[d] done so ..."⁷⁰ The court read the statutory state law claim in a much narrower fashion. It held that section 3344 applied only to commercial appropriations, but that it did not have to be limited to present or current use. Since the court felt that Abdul-Jabbar's identity had been appropriated by the defendant, and that it was a commercial appropriation, it held both state law causes of action to have sufficient facts to state a claim, therefore, summary judgment was inappropriate.

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66. *Id.*

67. *Id.*

68. *Id.* at 411-2.

69. *Id.* at 412.

70. *Id.* at 414.